

REMARKS

Status of claims and amendments

Claims 1-41 are pending in the application. Claims 1-6 have been withdrawn. In the Office Action dated April 24 2007, the Examiner:

1. rejected claims 39 and 40 under 35 U.S.C. 112, second paragraph ,as being indefinite. for recitations without antecedent basis (rendered moot by the cancellation of the subject claims);
2. rejected claims 11-14, 16, 17, 27-29 ,32, 33, 35, and 36 under 35 U.S.C. 102(e) as being anticipated by Whaley;
3. rejected claims 11, 18, 20-24, and 26 under 35 U.S.C. 102(b) as being anticipated by La Torraca;
4. rejected claims 11, 25, 29-31 ,39, and 40 under 35 U.S.C. 102(b) as being anticipated by Deschenes et al. '507;
5. rejected claims 11-13, 15, 29, 30, 32, and 34 under 35 U.S.C. 102(e) as being anticipated by Bonutti;
6. rejected claims 7-10 under 35 U.S.C. 103(a) as being unpatentable over Merser in view of Robbins;
7. rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over La Torraca in view of Robbins; and
8. rejected claims 37, 38, and 41 under 35 U.S.C. 103(a) as being unpatentable over Deschenes et al. '507 in view of Robbins.

In this amendment, claims 1-6 are canceled without prejudice to the Applicant's right to pursue the subject matter thereof in a divisional application. Claims 29-40 are canceled merely to reduce the total number of claims and because their limitations appear in other, non-canceled claims. Cancellation is not for reasons of patentability. Independent claim 11 and dependent claim 12 has been amended. New claims 42-44 are presented. No new matter is added.

Merser, Robbins, Whaley, La Torraca, and Deschenes

The present invention is fundamentally a medical device, whereas all of the prior art relied on by the Examiner (save Bonutti, which will be addressed below) is limited to the sewing art, and more particularly button attachment. The Examiner appears to have missed this fundamental point.

Turning first to claims 7-10 and 41, this group of claims specifically recites first and second pledgets. A pledget is not just any random member or button, but rather a specific medical term whose common meaning is well understood in the art to refer to a compress for closing or protecting a wound, which may or may not be absorbent. (See, e.g., Taber's Cyclopedic Medical Dictionary, p. 1114, copy enclosed). Thus, contrary to the Examiner's assertion, none of the cited references, in particular Merser, Robbins or Deschenes, discloses a pledget. Similarly, being limited to the button attachment art, they cannot be considered to suggest or teach under any standard a specific medical device such as a pledget. For this reason alone, this group of claims is patentable over the cited references.

Further, with respect to claims 7-10, there is no motivation to combine Merser and Robbins. Merser is concerned with providing simplicity and speed to the task of button application (column 1, lines 35-41), and providing an additional button as required by Robbins would be detrimental to this goal. Further, the Examiner's motivation to combine, namely to "protect fabric or tissue from chafing or ripping by first and second securing elements...and...prevent the securing elements from being pulled through the holes in the relatively more pliant fabric or tissue" is not a concern in Merser's device. Merser's head 2 is itself large enough not to chafe, rip, or be pulled through. In addition to slowing and complicating Merser's method, a second button would be completely unnecessary, and therefore would not be added to Merser's device by a person of ordinary skill in the art. There is thus no reason to make the proposed combination.

Moreover, with respect to claim 41, the specific combination cited by the Examiner cannot be made because functionality of the primary reference would be destroyed by combination with the secondary reference. Specifically, Deschenes discloses that the holes in its button are dimensionally larger than the feet 21, 23 of the end portions. This allows the feet to freely pass through holes B1 and B2. Feet 21, 23 are pushed through the garment by force. However, if a button was placed on the backside as proposed by the Examiner, such a button would necessarily have holes sufficient to let the feet pass through as disclosed. Such a button would then also simply fall off as soon as it was released. Additionally, while pushing the large round feet through woven fabric may be acceptable, forcing such blunt objects through human tissue is neither desirable nor practicable.

With respect to the anticipation rejections of claims 11-18 and 20-29, independent claim 11 and claims dependent thereon have been amended herein to recite that the suture material is suitable for use in suturing human or animal tissue in vivo and the securing elements comprise biocompatible material. These limitations are not disclosed in any of the cited references and the claims are therefore patentable thereover.

Further, Applicant respectfully asserts that there is no motivation to make the device of any of the five above-mentioned references biocompatible or suitable for use in suturing human or animal tissue in vivo, and as such, they do not render the claimed invention obvious under 35 U.S.C. 103. As all five references are directed only to sewing, they do not suggest the desirability and thus the obviousness of making them biocompatible (see M.P.E.P. 2141 II). Further, none of these references are analogous art with the claimed invention. Please see the summary of *In re Oetiker* provided in M.P.E.P. 2141.01(a)(IV):

Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook"....The Board relied upon a reference which disclosed a hook and eye fastener for use in garments....The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments.

Applicant asserts that a person of ordinary skill in the art pertaining to the instant application, seeking to solve a problem of “tissue fixation” (which is recited in the preamble of all pending independent claims), would not be reasonably expected or motivated to look to fasteners for garments or upholstery any more than a person seeking to solve a problem of fastening a hose clamp would.

Merser, Robbins, Whaley, La Torraca, and Deschenes, then, do not anticipate, or render obvious, independent claims 7, 11, 29, and 41. All pending claims are thus patentable over Merser, Robbins, Whaley, La Torraca, and Deschenes. Withdrawal of this rejection is respectfully requested.

Bonutti 7,087,073

Bonutti 7,087,073 was relied on under 35 U.S.C. 102(e) as allegedly teaching “first and second securing elements (18,20).” However, it is respectfully noted that this reference cannot be classified as prior art under §102(e), at least where anchors 18, 20 are concerned.

Bonutti 7,087,073 is a divisional of now patent 6,635,073, filed on February 21, 2001, which is a C.I.P. of now patent 6,592,609, filed on May 3, 2000. However, 6,592,609 discloses only one anchor (20, 100, 158, 188, 260 in the embodiments illustrated in Figures 1-4, 5-6, 7-8, 9, and 11-12, respectively). The §102(e) date of Bonutti’s two anchors 18, 20 is thus the filing date of now patent 6,635,073: February 21, 2001.

The present application is a C.I.P. of now patent 6,821,285, which is a C.I.P. of now patent 6,494,888, which was filed on May 19, 2000. Patent 6,494,888 clearly discloses two securing elements 824a, 824b, referring especially to Figures 6A and 8, and column 5, lines 50-51. The §102(e) date of the inventive two securing elements is thus the filing date of now patent 6,494,888: May 19, 2000.

As the inventive §102(e) date is before the §102(e) date of Bonutti’s anchors 18, 20, it is respectfully asserted that the inventive securing elements are patentable over 35 U.S.C. 102(e). Withdrawal of this rejection is respectfully requested.

Conclusions

In view of the foregoing, it is believed that all claims now pending in this Application are in condition for allowance. Should the Examiner have any continuing objections, the Applicant respectfully asks the Examiner to contact the undersigned at 415-442-1603 (direct line) in order to expedite allowance of the case. Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (matter no. 064391-5010-US).

Respectfully submitted,

Date: October 24, 2007 By: 
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